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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,691	07/25/2001	Amy E. Messner	10005172-1	7616

7590

11/22/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,691

Applicant(s)

MESSNER ET AL.

Examiner

James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on October 24, 2005 under 37 CFR 1.111 is sufficient to overcome the previous 35 U.S.C. 102(b) rejection in view of the Begum et al (5,420,606) reference. The amendment canceled Claims 6 and 20-23. Claims 7-19 were previously cancelled. Therefore, the currently pending claims considered below are Claims 1-5.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Begum et al (5,420,606) in view of Fajkowski (5,905,246).

Claims 1-5: Begum discloses a system for delivering and redeeming coupons wirelessly, comprising:

- a. a coupon service provider coupled to a plurality of valid merchants through a public wide area network (col 5, lines 31-39);
- b. delivering an electronic coupon through the public wide area network to a portable communication unit (col 2, lines 5-47 and col 3, lines 4-53);

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c. transmitting the coupon to a coupon provider via a short range private wireless receiver upon activation via a user interface (col 2, lines 5-47; col 3, lines 4-53; and col 5, lines 6-44);

d. receiving approval to redeem the coupon from the coupon provider (col 2, lines 5-47; col 3, lines 4-53; and col 5, lines 6-44); and

e. calculate the final price for the item upon receiving the approval (col 2, lines 5-47 and col 5, lines 6-44).

While Begum discloses that the coupons (promotions) are transmitted through “a modem for communication with a regional or national network” (col 3, lines 35-43) and that the system “periodically communicates with a coupon redemption center computer (not shown) for coupon crediting and accounting via radio or microwave transmitter, or by use of a low cost telephone modem” (col 5, lines 31-35), it is not explicitly disclosed that the “regional or national network” is a public wide area network, such as the Internet. However, Fajkowski discloses a similar system for delivering and redeeming electronic coupons which transmits the coupons over a public wide area network, such as the Internet, to a coupon card (smart card) and receives the redeemed coupons from a plurality of merchant computers (col 5, lines 15-17; col 6, lines 20-26; and col 29, lines 45-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention as made to use a wide area network, such as the Internet, as the regional or national network in Begum. One would have been motivated to use such an established wide area network in order to eliminate the need for the system owner to

develop and field its own private regional or national wide area network, thus decreasing the cost to set up and run the system.

While Begum discloses verifying that the data of the coupon being redeemed matches stored data of valid coupons and that the redeemed coupon information is transmitted to the remote systems controller and coupon redemption center (col 5, lines 10-39), it is not explicitly disclosed that the redeeming merchant will also be verified as a valid merchant. However, Fajkowski discloses a similar system for delivering and redeeming electronic coupons which not only verifies the coupon data, but also discloses a fraud prevention method in which merchants can be placed on a suspend list so that "their coupons are no longer accepted for reimbursement" (col 3, lines 17-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use similar "suspend lists" in Begum in order to validate the merchant. One would have been motivated to validate the merchant in Begum in addition to validating the coupon in order to reduce the amount of fraud as discussed by both Begum and Fajkowski.

Response to Arguments

4. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

The Examiner notes, however, that contrary to Applicant's assertion Begum discloses issuing and redeeming coupons from stores **and** manufacturers, not only in-store coupons (col 1, line 63 – col 2, line 2 and col 5, lines 31-39).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

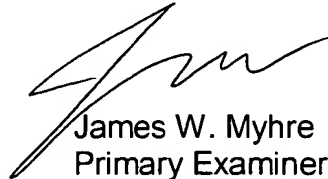
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (571) 273-8300. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.



JWM
November 15, 2005



James W. Myhre
Primary Examiner
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